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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/710,463	11/10/2000	John R. Toepfer	28681/91419	5216

23644 7590 01/27/2004

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EXAMINER

VAUGHN, GREGORY J

ART UNIT	PAPER NUMBER
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2178

DATE MAILED: 01/27/2004

8

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No. 09/710,463		Applicant(s) TOEPFER ET AL.	
Examiner Gregory J. Vaughn		Art Unit 2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 November 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 November 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Application History

1. This action is responsive to the application filing, Application filed on 11/10/2000.
2. Claims 1-4 are pending in the case, claims 1, 2, 3 and 4 are independent claims.

Drawings

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "54" in Figure 3 has been used to designate both a "Notepad Applet" and "Transaction Server". A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.
4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description:

- "40" on page 15, last line.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description:

- "20" in Figure 2.
- "22" in Figure 2.

A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

6. The disclosure is objected to because of the following informalities:

- The disclosure recites "*content libraries 40*" (page 15, last line) in reference to Figure 2. Reference sign 22 is directed toward "*Content Libraries*".
- The disclosure indicates on page 23, second paragraph, that an appendix was included in the disclosure. The application currently filed with the US PTO does not include an appendix.
- The disclosure recites "*data mapper 54*" (page 25, second paragraph) in reference to Figure 3. Reference sign 56 is directed toward a "*Data Mapper*".
- The disclosure recites those reference signs listed in paragraph 4 above, which are not shown in the drawings.
- The disclosure fails to disclose those reference signs listed in paragraph 5 above, which are shown in the drawings.

Appropriate correction is required.

7. The use of the following trademarks has been noted in this application:

- "Quark" on pages 11, 14 (twice), 16, 21 and 22.
- "MS Word" on page 14.
- "InDesign" on page 14.
- "Microsoft Internet Explorer 4" on pages 24 and 25 (twice).
- "Netscape" on pages 24 and 25.
- "Windows NT4" on page 26.
- "Oracle Corporation" on page 26.
- "Quark Express" on page 28.
- "SQL Server" on page 26, page 29.
- "Sybase" on page 26.
- "Oracle 7x" on page 29 (twice).
- "Oracle 8" on page 29.
- "Oracle 8i" on page 29.

It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

8. The disclosure is objected to because it contains the following embedded hyperlinks and/or other form of browser-executable code:

- "<http://java.sun.com>" on page 8, third paragraph.

Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

9. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

"A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language."

11. Claims 1-4 are rejected under 35 U.S.C. 102(e) as being anticipated by Jarett US Patent 6,195,665 (filed 3/5/1996, patented 2/27/2001).
12. **In regard to independent claim 1**, the preamble of the claim is directed toward a computer system for producing a recurring document. Jarett discloses a computer

system where *"pages are assembled into a bound briefing book"* (column 3, line 30) from a template, where *"The Template is called the Financial Statement Template-- Annual. The Template compares actual data for the current year with current data from the previous year"* (column 4, lines 33-35).

The first limitation of the claim is directed toward selecting data and content for a document. Jarett discloses a data selection screen in Figure 57 and *"select one of the case statements, the range limit, and the corresponding sentence"* (column 10, lines 15-16)

The second limitation of the claim is directed toward assembling the data and the content into a document. Jarett discloses: *"(C) organizing, by the processor, the input data into the portions of the template to fill the empty charts (i.e., charts not completely filled with data) and the empty plots (i.e., plots not completely not filled with data) to show respective representations of the input data, and to fill the space with the text representing the input data, the portions being assembled"* (column 11, lines 13-19).

The third limitation of the claim is directed toward independent display and control of the data and the content. Jarett discloses a financial data entry screen with controls in figures 57-59. Jarett discloses content display screen with controls in figure 60.

The forth limitation of the claim is directed toward combining the data and the content into a document. Jarett discloses: *"The text is formed by combining the explanatory sentence with other text formed by testing the subsequently input*

template data to select one of the case statements, the range limit, and the corresponding sentence" (column 10, lines 13-16).

The fifth limitation of the claim is directed toward reviewing the document. Jarett discloses a review screen in figure 60.

The sixth limitation of the claim is directed toward approving the document. Jarett discloses: "*Pursuant to step 7, the user views all of the pages for a final approval*" (column 21, lines 60-61).

The seventh limitation of the claim is directed toward outputting the document. Jarett discloses: "*At step 8, the user opens the print options, selects the ones that best fit the current print needs, and prints the Briefing Book for distribution*" (column 21, lines 62-64). Jarett also discloses: "*The output of the Show, as indicated in FIG. 11, is a set of files that can be viewed but the data cannot be changed or altered. The Show can be stored on any magnetic media and the numbers in the Show cannot be changed. The Show can be created to allow or not to allow changes in the words, the voice sound or the chart colors*" (column 22, lines 4-9).

13. **In regard to independent claims 2, 3, and 4**, the claims are directed toward a system or method that contain substantially the same subject matter as claim 1, and are rejected with the same rational.

Conclusion

14. The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Art Unit: 2178

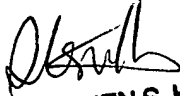
<u>Patent</u>	<u>Date</u>	<u>Inventor</u>
• US-5,377,355	12-1994	Hager et al.
• US-5,537,526	07-1996	Anderson et al.
• US-5,638,504	06-1997	Scott et al.
• US-5,715,441	02-1998	Atkinson et al.
• US-5,781,732	07-1998	Adams, William
• US-6,052,514	04-2000	Gill et al.
• US-6,199,082	03-2001	Ferrel et al.
• US-6,341,290	01-2002	Lombardo et al.
• US-6,662,343	12-2003	Gebauer, Niels

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Vaughn whose telephone number is (703) 305-4672. The examiner can normally be reached Monday to Friday from 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R. Herndon can be reached at (703) 308-5186. The fax phone number for the organization where this application or proceeding is assigned is (703) 746-7239.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Gregory J. Vaughn
January 20, 2004


STEPHEN S. HONG
PRIMARY EXAMINER